

REMARKS

Claims 58-81 are pending in this application. Claims 58, 69 and 80 are independent.

The Examiner's notation that the present application currently includes informal drawings which are acceptable for examination purposes only, is acknowledged. Formal drawings will be submitted promptly after receipt of a Notice of Allowability in this case.

The withdrawal of the prior rejection of claim 81 under 35 USC §112, second paragraph, is acknowledged with appreciation.

It is noted that on page 11 of the above-referenced Official Action, claims 63 and 74 are noted as being objected to, but allowable if rewritten in independent form. In view of the Examiner's discussion of these claims beginning at top of page 4 of the Official Action to which this response relates, and a telephone discussion with the Examiner on June 21, 2004, it is understood that the paragraph entitled "Claim Objections" was inadvertently included on page 11, and that the Examiner has maintained the rejection of claims 63 and 74 as anticipated under 35 USC §102(e) by Van Dusen.

The withdrawal of the rejection of claims 66, 77 and 78 as obvious over Van Dusen, in view of Lenhart and Official Notice, is acknowledged with appreciation.

Accordingly, as understood, claims 58, 63, 65-69 and 74-79 stand rejected under 35 USC §102(e) as anticipated by Van Dusen (U.S. Patent No. 6,175,823), claims 58, 65, 67-69, 75-76, and 79-80, stand rejected under 35 USC §103(a) as obvious over Van Dusen in view of Lenhart (Lenhart, J. "Happy Holidays, High-Tech Style: Sending Cards

over the Internet Gains Popularity", The Washington Post (December 20, 1998). Claims 59-62, 64 and 70-73 stand rejected under 35 USC §103(a) as obvious over Van Dusen in view of Albrecht (U.S. Patent No. 5,984,180), or alternatively over Van Dusen, in view of Lenhart and Albrecht. Claim 81 stands rejected under 35 USC §103(a) over Van Dusen in view Lenhart and Official Notice. The rejections are respectfully traversed.

The traversal arguments previously submitted in response to previous Office Actions rejecting claims on similar grounds are hereby incorporated by reference and reasserted here in their entirety.

On pages 2-11 of the Final Official Action, the Examiner responds to the traversal arguments presented in the response filed on January 29, 2004.

In addressing the previously submitted traversal arguments relating to the anticipation rejection of independent claims 58, 69 and 80 based on Van Dusen, the Examiner points to the present application specification on page 65, line 13, which discloses that an e-mail may be the entire e-card. In view of this disclosure, the Examiner now argues that the electronic greeting card required by each of independent claims 58, 69 and 80 corresponds to Van Dusen's e-mail based gift certificate, because Van Dusen teaches an e-mail message being sent to a recipient in order to communicate the giving of a gift certificate.

However, as discussed in detail in the prior responses to Official Actions, an e-card, which is also commonly referred to as an electronic greeting card, has a very specific meaning in the art that the Examiner continues to ignore. The referenced specification text (which is believed to appear on page 64, lines 8-9, not on page 65,

line 13), simply discloses that an e-mail message may take the form of an e-card, as is further clarified in the next sentence of the specification (see page 64, lines 9-10). Thus, what is disclosed in the referenced text of the present application is that an e-mail message having the attributes of an electronic greeting card (i.e. an e-mail message which allows the sender to include, in addition to his/her own text, different backgrounds, images and/or music, so as to be an electronic equivalent to a paper greeting card).

Accordingly, Van Dusen's disclosure of an e-mail message that communicates the giving of a gift certificate lacks any suggestion whatsoever of an e-mail message which takes the form of an electronic greeting card, and Applicant has not admitted anything to the contrary. Rather what Applicant has explicitly disclosed is that an improved type of e-mail message can be utilized in combination with the giving of a monetary gift.

It is further noted that this difference is more than a simple change in form of a message. Rather, as described in detail on pages 62-68 of the application, the invention requires novel and unobvious functionality which does not exist and is not disclosed in Van Dusen or any other prior art applied by the Examiner. Accordingly, the Examiner's use of "electronic greeting card" and "e-mail" interchangeably is inconsistent with the recognized meaning of these terms in the art, as well as the present application specification.

The combination of Lenhart's teachings with those of Van Dusen also fails to overcome the deficiencies in Van Dusen.

Even if those of ordinary skill in the art had recognized the benefit of being able to include a monetary gift with an electronic greeting card (which is not at all clear from the applied art), there is nothing within the applied combination of art to suggest that the applied art could be combined to accomplish that objective. Furthermore, there is nothing within the applied prior art to suggest how one would go about combining the teachings of the respective references to accomplish this objective. Hence, there is no motivation to combine the references to meet such an objective.

Further still, in order to include a monetary gift with an electronic greeting card, requires more than simply digitizing a previously known manual process. Indeed, numerous previously unsolved issues and problems had to be addressed by the present inventors. The solutions to these issues and problems are reflected in the present application disclosure. The applied combination of art lacks any recognition of these issues and problems, and hence also fails to provide any disclosure of how to provide monetary gifts with electronic greeting cards.

With respect to claims 63 and 74, the Examiner's position cannot be understood. More particularly, these claims require that a generated electronic greeting card, which includes a monetary gift, be transmitted to a designated recipient (i.e. a recipient designated by the requesting donor). Additionally required is that this electronic greeting card be further transmitted to a non-designated recipient (i.e. a recipient not designated by the donor), and that the hyperlink in this further transmitted electronic greeting card be activated and that information identifying the non-designated recipient be received via the activated hyperlink.

As can best be understood, the Examiner argues that Van Dusen, in column 6, lines 61, through column 7, line 4 (not column 5, line 4), somehow teaches these limitations. However, what is taught in the reference section of Van Dusen is having multiple hyperlinks, not multiple transmissions to different recipients. Hence, contrary to the Examiner's assertion, Van Dusen lacks any teaching or suggestion of these limitations, and claims 63 and 74 clearly distinguish over the applied prior art on these grounds alone.

Furthermore, claims 63 and 74 further require that the deposit account be at a financial institute. It appears the Examiner has completely ignored this limitation.

Claims 66 and 77 require that the request to send an electronic greeting card and to make an associated monetary gift on behalf of a requesting donor to a designated recipient be received from a greeting card service.

The Examiner asserts that this limitation is inherent to Van Dusen, but fails to provide any reasonable support for this bald assertion. The Examiner points to column 5, lines 29-31, and column 6, lines 35-36, as somehow disclosing the required limitations, but fails to explain how the referenced Van Dusen disclosure is relevant. Instead, the Examiner seems to be arguing that a gift certificate application submitting a command to an Internet service provider (ISP) to transmit an e-mail to a designated e-mail account somehow is equivalent to the required limitations. However in view of the applicable limitations, these arguments appear to have no relevance.

Claims 67 and 78 require that the request to send an electronic greeting card and to make an associated monetary gift on behalf of a requesting donor to a designated recipient, be received and processed by electronic greeting card service, and that the

generated electronic greeting card be transmitted by such electronic greeting card service; but that the crediting of funds equal to the monetary gift amount be credited to the deposit account by a payment service.

Once again, the Examiner's arguments in support of the rejection of these claims cannot be understood. Although the Examiner asserts that Van Dusen issues an electronic greeting card, this is simply incorrect. Furthermore, even if Van Dusen did have some teaching of electronic greeting card, it is the Van Dusen system (not a separate payment service) which directs the crediting of the gift certificate amount to an account. Indeed, nowhere within Van Dusen is there any suggestion of separate services or entities, one of which generates and transmits notices of a gift and another of which credits an account in an amount corresponding to the gift. The Examiner appears to confuse Van Dusen's required debiting of a credit card with the depositing of the gift certificate amount in a unique gift account (see Van Dusen column 6, line 61, through column 7, line 4).

Furthermore, the addition of Lenhart does not overcome this deficiency, and although the Examiner now baldly asserts that it does, the Examiner provides no reasonable support for this conclusion.

The Examiner offers no response to the traversal arguments presented with respect to the rejection of claims 65 and 76, or 68 and 79. Accordingly, the rejection of these claims also cannot reasonably be understood.

Claims 59 and 70 require that an electronic greeting card be transmitted to the designated recipient either subsequent to, or concurrent with, the directing of the crediting of the funds to the deposit account.

The Examiner acknowledges that Van Dusen and Lenhart, fail to disclose this limitation, and applies Albrecht's teachings to overcome this deficiency. However, the Examiner also acknowledges that Albrecht actually teaches crediting an account prior to transmitting greeting card, but argues that the changing of a sequence of steps in a method is obvious absent some unexpected result (citing *In re Lindberg*, 93 USPQ 23).

However, the recited limitations have nothing whatsoever to do with a sequencing of steps. Rather what the recited limitations provide is substantially different functionality from that of Albrecht, and result in a benefit not obtainable by Albrecht (i.e. the potential availability of the credited funds to the recipient, either at the time of the recipients receipt of the electronic greeting card or promptly thereafter). Albrecht fails to even recognize this potential benefit, and discloses a system which is incapable of accomplishing such an objective.

Claims 60 and 71 require the directing of funds to be credited to the deposit account subsequent to an activation of a hyperlink, and that the deposit account be at a financial institution.

The Examiner asserts that "all features that are not taught by a single reference, are expressly stated as missing from the single reference. Thus, negative implication dictates that any features not addressed are taught by the primary of reference. Though not expressly stated, Van Dusen was therefore offered for its teaching of crediting a recipient's account after the activation of a hyperlink. Van Dusen teaches this limitation in Fig. 2, which depicts the e-mail that the gift recipient receives. This figure features a "click here" hyperlink 30, that allows the recipient to "automatically

deposit the \$40 gift certificate amount into [his] personal account". Accordingly, Van Dusen teaches crediting the recipient's account after activation of a hyperlink".

The Examiner's position is not understood. The Examiner has acknowledged that Van Dusen lacks any teaching or suggestion of a deposit account at a financial institution. Hence, the Examiner's argument makes no sense on this basis alone. Furthermore, the Examiner has failed to offer any rationale as to why there would be any motivation to modify Van Dusen to make deposits in deposit accounts at financial institutions, since Van Dusen is only concerned with gift certificates.

Accordingly, it is respectfully submitted that the Examiner has failed to provide any reasonable basis for the rejection, and therefore the rejection cannot be understood.

Claims 64 and 75 require that a payment account at a financial institution associated with the donor be debited subsequent to the activation of a hyperlink included in the transmitted electronic greeting card.

The Examiner argues that this is nothing more than a change in the sequence of known steps.

However, this is not simply a change in a sequence of steps. What the Examiner fails to recognize are the benefits of the required timing of the debiting in accordance with the limitations of claims 64 and 75. For example, debiting the payment account subsequent to the activation of the hyperlink in the transmitted electronic greeting card, will eliminate any need to credit back gift amounts to the donor's account if the intended recipient cannot be located, fails to respond or refuses the gift. Once again, the applied

art does not even recognize the benefits of the delayed debiting required by claims 64 and 75.

Claim 81 requires directing a debiting of funds equal to the monetary gift amount from a deposit account at a financial institution associated with the requesting donor, to a deposit account at a financial institution associated with the service provider. Also required is the directing of funds to be credited to the deposit account recited in claim 58 (e.g., the deposit account of the designated recipient), from the deposit account associated with the service provider.

The Examiner acknowledges that these limitations are missing from Van Dusen and Lenhart, and now cites a Credit Card News publication ("Person-To-Anywhere Payments Are Here With Citibanks C2it") (November 15, 2000), and a Bank Technology News publication ("You've Got Money!") (June, 2000) Volume 13, No. 6, page 1), in support of the Official Notice.

However, in the highlighted portion of the Credit Card News publication (i.e. the second paragraph of text), there is nothing to suggest that the debit results in a payment to a Citicorp account rather than to the payees account.

Likewise, in the highlighted sections of the Bank Technology News publication, there is no disclosure or suggestion of a service provider account. Indeed, in paragraph 6 of the publication text, it is explicitly disclosed that the customer must establish a Pay Pal account. Hence, there is no need for pay pal to debit money from a payors account to a Pay Pal account.

Thus, the Examiner has failed to provide support for the Official Notice. Furthermore, it is entirely unclear why one would be motivated to modify the result of

any combination of Van Dusen and Lenhart to include the required service provider account at a financial institution.

It is noted that in the Response filed on January 29, 2004, the remarks correctly indicate that claims 69, 72, 74 and 81 were amended. However, in the listing of claims, claim 61 should have been identified as "(Previously Presented)", rather than "(Currently Amended)", and claim 74 should have been indicated as "(Currently Amended)", rather than "(Previously Presented)".

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of

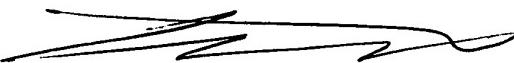
Docket No: 3350-42B
File No. 1158.41327CC2
Client Ref: MoneyWeb-B

Expedited Procedure Requested

this paper, including extension of time fees, to the Deposit Account No. 01-2135
(Case No. 1158.41327CC2) and please credit any excess fees to such Deposit
Account.

Respectfully submitted,

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